

REMARKS

This is in full and timely response to the final Office Action mailed September 30, 2004. Entry of this Amendment is proper under 37 C.F.R. §1.116 since the amendment: (a) places the application in condition for allowance (for the reasons discussed herein); (b) does not raise any new issues requiring further search and/or consideration; (c) satisfies a requirement of form asserted in the previous Office Action; and (d) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made to further limit the independent claim in response to the final Office Action. Entry of this amendment is respectfully requested. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

By this Amendment, claim 3 was amended to recite that the ratio of isocyanate group in the (D) component to 1 equivalent of hydroxyl group in the (A) component is greater than 2.0 equivalents and less than or equal to 4.0 equivalents. Support for this claim can be found variously throughout the specification, for example, page 9, line 2-12. Claims 5 and 6 were amended to depend from claim 4. No new matter was added.

Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

Rejections under 35 U.S.C. §112

Claims 1-5 and 7 were rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the written description requirement. Applicants respectfully traverse this rejection.

However, in order to expedite prosecution, claims 1-2 were canceled, mooted this portion of the rejection.

Additionally, claim 3 was amended to delete the phrase “said resin fine particles are one of solid and powder,” mooted this portion of the rejection.

Regarding the rejection of the phrase “greater than 2.0 equivalents and less than 4.0 equivalents,” Applicants traverse this rejection.

The Office Action alleges that there is no support in the specification for this claim element, and refers to *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

The examiner is reminded that the MPEP is not law, as it has not been subject to the Administrative Procedures Act, and accordingly, does not control.

As the examiner has not pin-pointed the citation to *In re Wright*, the examiner has de facto not established a prima facie case, and the burden has not shifted to the Applicants.

However, in order to expedite prosecution, Applicants will address this rejection.

As acknowledged in the Office Action at page 3, second full paragraph, the specification clearly provides support for a lower limit of 2 or 2.2, and an upper limit of 4 or 3.5. The Office Action alleges that the specification does not support lower limit values of, for example, 2.05, 2.1, and upper limit values of, for example, 3.8 and 3.9. The Office Action is clearly incorrect, a prima facie has not been established, and this rejection is improper.

In *In re Wright*, the Federal Circuit commented that “the exact words here in question ... are not in the specification is not important.” *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989). The Federal Circuit held that the lack of explicit recitation of this phrase in the specification was not dispositive of a prima facie case.

The examiner has never alleged that the original claim element “2.0 to 4.0 equivalents” was not support by the specification. See *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976). The examiner must have a reasonable basis to challenge the adequacy of the written description, and the examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in the disclosure the claimed invention. The examiner has not set forth any express findings of fact, let alone a discussion of one of skill in the art. See *In re Wertheim*. Accordingly, a prima facie case has not been presented.

It is well established that the original claim element, “is 2.0 to 4.0” encompasses all values between 2.0 and 4.0. *In re Wertheim*. In fact, *In re Wertheim* discusses an original range of “25%-60%”, and had specific examples of 36% and 50%. The court concluded that the limitation “between 35% and 60%” did meet the description requirement. See also MPEP at 2163.05, III. Thus, the examiner’s acknowledgement of the values between 2.0 and 4.0 is de facto acknowledgement of support for greater than 2.0 and less than 4.0 when taken in context of the claim, the specification, and *In re Wertheim*.

Accordingly, the claim element “greater than 2.0 equivalents and less than or equal to 4.0 equivalents” is fully supported in the original claims and specification, and the examiner has not presented a prima facie case. Withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1-8 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,706,801 to Blum et al. Applicants respectfully traverse this rejection. In order to expedite prosecution, claims 1-2 were canceled without prejudice or disclaimer to their underlying subject matter, mooted this portion of the rejection.

Claim 3 was amended to recite that the ratio of isocyanate group in the (D) component to 1 equivalent of hydroxyl group in the (A) component is greater than 2.0 equivalents and less than or equal to 4.0 equivalents.

The Office Action alleges that Blum et al. “disclose that the ratio is at least 0.5 equivalents...which clearly encompasses the ratios presently claimed.” Office Action at page 4, paragraph 5. Applicants wish to point out that this is an incomplete assessment of what is disclosed, taught and suggested by Blum et al. ‘801 at the referred to column 13, lines 35-36.

Specifically, Blum et al. ‘801 recites, at column 13, lines 35-39:

At least 0.5 equivalent of polyisocyanate b) is employed per equivalent of isocyanate-reactive groups in polymer a) and in optionally co-used component e). Preferably, 0.8 to 2.0, particularly preferably 1 to 1.4 equivalents of polyisocyanate b) are employed per equivalent of hydroxyl groups in polymer a).

Thus, it is abundantly clear that the “at least 0.5” is disclosing, suggesting and teaching a lower limit, and the 2.0 is disclosing, teaching and suggesting an upper limit. When read in context, the phrase “at least 0.5” can have no other meaning than a minimum value. Still further, Applicants assert that one of skill in the art would understand this to mean that “at least 0.5, but no more than 2.0 equivalents” are to be used in Blum et al. ‘801.

Accordingly, there is no overlap of the claimed range, therefore all of the claim elements have not been disclosed, taught or suggested by Blum et al. ‘801.

Still further, as Blum et al. ‘801 discloses, teaches and suggests that the amount of polyisocyanate is “at least 0.5, but no more than 2.0 equivalents”, it is suggested that amount greater than 2.0 equivalents would not allow Blum et al. ‘801 to function as disclosed and taught. Accordingly, a prima facie case of obviousness has not been presented.

Since Blum et al. '801 fail to disclose, either explicitly or implicitly, teach or suggest at least the above-noted elements recited in independent claims 3 and 4, Blum et al. '801 cannot render the claims unpatentable. At least in view of the foregoing, claims 3 and 4 are allowable, and the rejection should be reconsidered and withdrawn.

Additionally, claims 5-8, being dependent upon allowable claim 4, are also allowable for the reasons above. Moreover, this claim is further distinguished by the additional features recited therein, particularly within the claim combination.

Accordingly, withdrawal of the §103 rejection is respectfully requested.

Conclusion

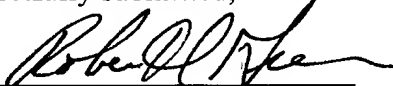
For the foregoing reasons, claims 3-8 are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of these amendments and remarks is courteously solicited. If the examiner has any comments or suggestions that would place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number below.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. KPC-294 from which the undersigned is authorized to draw.

Dated: November 18, 2004

Respectfully submitted,

By 

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